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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,703	07/17/2003	Yoshitaka Sakoh	02410335AA	9315
30743 7590 09/16/2008 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190				
EXAMINER RENWICK, REGINALD A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/620,703

Applicant(s)

SAKOH, YOSHITAKA

Examiner

REGINALD A. RENWICK

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/23/2008.
2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 5-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. Patent No. 5,207,426) in view of Voll (U.S. Patent No. 5,268,542).

Re claims 1 and 6: Inoue discloses a controller (Field of Invention), comprising: a main board, on which an electrical component is mounted and extending in a first direction (column 4, lines 28-33, 38-42); a switch board, provided so as to extend in a second direction perpendicular to the first direction (object 14 of Figure 5, column 5, lines 40-55); a push switch, mounted on the switch board and electrically connected to the electronic component, the push switch adapted to be pushed in the first direction (object 141 of Figure 5) ; and a switch board holding member, holding the switch board and integrally formed with the parts holding member which one will notice by observing Figure 5 which shows in detail an extension from the controller towards the switchboard to hold the switch board. Because Inoue discloses that the switchboard is directly connected to the main board, Inoue fails to disclose that the parts holding member is

interposed between the switch board and the main board and adapted to receive a stress generated when the push switch is pushed. However, Voll discloses a parts holding member for a push button that contains a space portion (object 14 of Fig.1) that separates the switch board from the main board. It would have been obvious to one skilled in the art to provide a spacer between the main board and switch board in order to protect the main board from damage that may occur during the constant use of the push button.

2. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Voll in further view of Tickle (U.S. Patent 5,670,988).

Re claims 5 and 7: Inoue fails to disclose a battery for the game controller. However, Tickle discloses that the controller comprises of a battery terminal holding member, holding a battery terminal and integrally and monolithically formed with the parts holding member (Abstract; Fig. 3) . It would have been obvious to one skilled in the art to incorporate a battery into the invention of Inoue as it is common in the art to use a battery as a source to power electrical items within a controller.

Re claim 8, 9, 10, and 11: Innoue fails to disclose the following limitations:
a first rib formed on the switch board holding member so as to receive a force generated by an operation of the push switch and that the first rib is in contact with the parts holding member and the first rib is formed with the parts holding member.

However the use of ribs within a button arrangement is notoriously well known in the art as place holders for various items and with push buttons in order to receive a force generated by an operation of the push switch. Such is displayed in Voll which discloses a push button operated multi-step switch, in a housing that contains a plurality of ribs and in particular ribs between ribs separating the switchboard and the circuit board (objects 2b and 14 on Fig.1.). The Applicant specifically states that the ribs act as a holding member, and thus the functionality is only limited to their placement among other parts in the structure which are previously held in place by ribs in their previous configuration. The examiner understands that the instant application describes the placement of the specific rib and Innoue and Voll in combination do not fully describe the claim language, however because said ribs are previously described in detail in the prior art, it would have been obvious to one skilled in the art to the placement of said ribs is a matter of simple design choice, as it does not add unexpected functionality to the controller.

Re claim 11: Tickle discloses a rib, formed on the battery terminal holding member and supporting the battery terminal (Fig. 3). (See discussion of claim 5)

Re claim 12: Much of the claim language has already been previously discussed in the above claims that describe Inoue as providing the same limitations. Furthermore Inoue provides a push key engaging said push switch to operate said push switch, said push key being provided to protrude from an inside of a housing of the game controller to a

front side of the game controller (object 141 on Figure 5). However, Inoue does not provide battery terminal holder portions formed on both left and right sides of the table portion and surrounded by said rib, battery terminals projecting via holes in the parts holder and contacting power supply circuit patterns of the main board, whereby the parts holder receives external force applied during battery replacement insulating the main board from mechanical stress. Voll discloses a battery located within a game controller, but does not specifically state the use of a table to separate the two batteries. As previously stated above, the examiner interprets this limitation as not adding unexpected functionality to the previous designs of holding a battery in place. Thus it would have been obvious to one skilled in the art as a simple matter of design choice for arranging the inner parts.

Re claim 13: Inoue fails to disclose that the parts holder is positioned by inserting pins into pin holes in the main board, the pin holes being provided to both ends of a bottom surface of the parts holder, and the parts holder is fixed to the main board by engaging hooks, which are provided to a rear edge of the bottom surface, with square holes formed in the main board. However, Voll discloses screws that attach the parts holding member to the main board, and it would have been common to one skilled in the art to substitute the engaging hooks for the screws and use square holes instead of round holes as disclosed by Voll, into the invention of Inoue as it is a slight change in design that does not provide extra functionality on a commonly known practice for connecting items.

Response to Arguments

3. Applicant's arguments filed 06/23/2008 have been fully considered but they are not persuasive. The examiner has not cited the method or orientation in which the spacers were positioned but instead merely that the spacers in connection with a parts holding member were present in the invention of Voll, and could reasonably be applied to the invention of Inoue. Furthermore Inoue discloses that the connection between the switchboard and the main board is not dependent on the placement of the switchboard which is located perpendicular to the main board and instead the switchboard is connected to the main board through lead wires (column 5, lines 53-55). Inoue also discloses rubber contacts located above the switchboard to protect the switchboard from impact of the game button (object 143 in Fig. 4), as well as further support in the parts holding member to keep the switchboard in place (Fig. 5). Therefore Inoue provides added consideration for the further protection of parts through the assembly process. This limitation is offered by Voll which discloses as stated above spacers in conjunction with a parts holding member to separate a switchboard and main board. The Applicant has argued that such a design could not be performed when the switch board is perpendicular to the main board. However, the examiner argues that the arrangement of said switch board and main board are irrelevant provided that the parts holding member separates the two, which the combination of Inoue and Voll accomplish.

4. The Applicant has also questioned the identification of a parts holding member in Inoue and particular Fig. 5. To clarify the parts holding member of Inoue is the device's housing member which comprises of objects 111 and 112 in Fig. 5 (column 4, lines 3-17). In addition, the examiner has combined the teachings of Inoue, Voll, with the teachings of Tickle whereby Tickle provides Inoue and Voll with a battery terminal monolithically attached to the parts holding member. The Applicant has suggested that such prior art is can not be reasonably combined because the parts holding member is not mounted on a main board. However, no where in the claim language of the currently amended claims nor previously presented claims is there mention of the parts holding member mounted on the main board.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a parts holding member that is specifically mounted on the main board) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,528,460 discloses a battery parts holding member located on top of a circuit board.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD A. RENWICK whose telephone number is (571)270-1913. The examiner can normally be reached on Monday-Friday, 7:30AM-5:00PM, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

RR
9/16/2008